REMARKS

Claims 1-17 are pending in the application. The status of the application is as follows:

Claims / Section	35 U.S.C. Sec.	References / Notes
Specification	Objection	• Informalities in paragraphs 4 and 8.
1, 3	Objection	• Informalities
1-8	§112, Second Paragraph Indefiniteness	• Lack of clarity in claim language.
1-12 & 15-17	§102(b) Anticipation	• Garvey, et al. (U.S. Patent No. 6,286,764).
13	§103(a) Obviousness	• Garvey, et al. (U.S. Patent No. 6,286,764); and • Rosenberg (U.S. Patent No. 6,300,937).
14	§103(a) Obviousness	• Garvey, et al. (U.S. Patent No. 6,286,764); and • Scheideler (U.S. Pub. No. 2003/0188583).

Pursuant to the request of the Examiner, and pursuant to 37 CFR §1.125(b), Applicants are concurrently submitting a substitute specification, excluding the claims, and provided a marked-up copy. All of the changes are editorial and applicant believes no new matter is added thereby. The amendment, addition, and/or cancellation of claims is not intended to be a surrender of any of the subject matter of those claims.

Applicants have amended the Specification and claims 1 and 3 as requested by the Examiner. Applicants thank the Examiner for pointing out these informalities. Applicants have further provided discussion for distinguishing the present invention from the art cited by the Examiner.

Applicants' use of reference characters below is for illustrative purposes only and is not intended to be limiting in nature unless explicitly indicated.

OBJECTION TO THE SPECIFICATION

1. Applicants have amended the Specification in accordance with the Examiner's recommendations.

Applicants have amended paragraphs [0004] and [0008] of the Specification in accordance with the Examiner's suggestions. Withdrawal of the objection to the specification is respectfully requested.

CLAIM OBJECTIONS TO CLAIMS 1 AND 3

2. Applicants have amended claims 1 and 3 pursuant to the Examiner's suggestions.

Applicants have amended claim 1 and 3 in accordance with the Examiner's suggestions with a slight variance as noted below. With respect to the item under numbered paragraph 3(b), the applicants have amended claim 1 to read that the actuator is controlled depending on the control signal.

Applicants therefore respectfully request that the objection to the claims be withdrawn.

35 U.S.C. §112, SECOND PARAGRAPH, CLAIMS 1-8 INDEFINITENESS

3. Applicants have amended claim 1 to provide a more definite recitation of the preamble.

Applicants have amended the preamble of claim 1 to clarify that the control element is moved by the actuator, but the actuator is controlled by the control unit. Applicants assert that this clarifies how the control element is

moved, but welcome any suggestions for clarification by the Examiner. Based on this amendment, Applicants respectfully request that the 35 U.S.C. §112 rejection be withdrawn from the application.

35 U.S.C. §102(b), CLAIMS 1-12 AND 15-17 ANTICIPATION BY GARVEY

4. Garvey fails to teach the element of detecting, via a measurement device, measurement signals that indicate the partial movement of the control element from the initial condition.

In the OA, on p. 4, the Examiner indicates that Garvey teaches, at 8/57-67, detecting, via a measurement device, measurement signals that indicate the partial movement of the control element from the initial condition.

Applicants disagree with this characterization of Garvey's teaching. Garvey states, in the portions cited by the Examiner:

> A variety of additional sensors are contemplated within the invention that will be apparent to the artisan based on the various system designs, functions and methods described herein. For example, a range of gas and fluid supply systems will incorporate fluid and gas composition sensors 52, which sensors are capable of measuring a wide range of important fluid composition parameters. Within domestic supply systems, exemplary compositional sensors are provided to measure system performance and health-related parameters, including gas or water particulate content, additives, volatile organics, water hardness, presence and/or concentrations of lead and other toxins, chlorine and/or fluoride content, bio-organics and microorganism content (eg., coliform bacteria levels), and like parameters. Commercial supply systems will be equipped with a similar range of composition sensors specifically adapted for the particular uses and requirements of the system.

Garvey does not disclose sensors that detect measurement signals that indicate partial movement of the control element from the initial condition—rather the sensors of Garvey detect process results and not movement of the control element. This is a substantial difference since detection of process results will not serve as a method or apparatus to test the operating safety of a process control device, which is claimed by all independent claims of the invention. One cannot infer movement of a control element based on a testing of parameters related to the product since numerous variables unrelated to the movement of the actuator could affect the product parameter measurement disclosed by Garvey.

Similarly, it is also possible that partial movement of the actuator may not result in any change that could be detected by the sensors disclosed by Garvey. Therefore, Garvey fails to teach or suggest this element of the independent claims. Advantageously, the detection by the measurement device of measurement signals that indicate the partial movement of the control element permits it to perform a proper test of the operating safety of a process control device that is not taught or suggested by Garvey.

5. Garvey fails to teach the element of controlling the actuator depending on the control signal aided by the control unit to operate the actuator for the <u>partial movement</u> of the control element from the initial condition..

In the OA, on p. 4, the Examiner indicates that Garvey teaches, at 6/26-28, a test cycle for the process control device comprising: generating a control signal for partial movement of the control element aided by the position controller.

Applicants disagree with this characterization of Garvey's teaching. Garvey states, in the portions cited by the Examiner:

> To actuate the hot and cold water supply valves 18, 20, the control motors 22, 24 receive one or more control signals via respective control connections 30, 32.

The only disclosure of movement by these valves is found at 5/58 which discusses opening and closing the valves, but does not provide any suggestion of partial movement of the control element. A similar disclosure is found at 6/43-44. Furthermore, Garvey does not contain any suggestion that any of the operations on the valves are performed as part of a testing of the operational safety of the process control device. While the preamble of a claim is not automatically limiting, "[a] preamble to a claim has the import that the claim as a whole suggests for it." Griffin v. Bertina, 285 F.3d 1029, 1033, 62 USPQ2d 1431, 1434 (Fed. Cir. 2002) (internal citation omitted). In this instance, the preamble defines the nature of the signals that are generated in the method and the apparatus claims, and this test nature is clearly not found in Garvey.

Garvey omits the above-identified steps in what is clearly necessary to perform a test of operating safety of the control system components. Namely, the present invention is able to activate and test a system in which *all* control components, the position controller, control unit, and respective connections, are all activated during the test routine and are therefore all checked.

For these reasons, Applicants assert that the laim language clearly distinguishes over Garvey, and respectfully request that the Examiner withdraw the §102 rejection from the present application.

35 U.S.C. §103(a), CLAIM 13 OBVIOUSNESS OVER GARVEY IN VIEW OF ROSENBERG

6. Applicants rely on the above-arguments and assert that the combination including addition of Rosenberg fails to teach the elements of the independent claims.

In the OA, on pp. 7-8, under numbered paragraph 6, the Examiner added the Rosenberg reference as disclosing the element of claim 13. Without addressing this argument on the merits, Applicants rely on the above arguments and assert that the addition of Rosenberg to the combination does not provide a teaching or suggestion for the elements of the independent claim.

Applicants note, however, that it would not be obvious to combine a reference dealing with the controlling of a force feedback device for a computer interface device in a comprehensive method and apparatus for testing the operating safety of a process control device, namely because the sensor of Rosenberg does not detect motion initiated in response to a system undergoing testing, but rather detects motion initiated by the user of an interface device—it would serve very little purpose to test a process control device according to the present invention if the user were to manually initiate the partial movement of the control element.

35 U.S.C. §103(a), CLAIM 14 OBVIOUSNESS OVER GARVEY IN VIEW OF SCHEIDELER

7. Applicants rely on the above-arguments and assert that the combination including addition of Scheideler fails to teach the elements of the independent claims.

In the OA, on pp. 8-9, under numbered paragraph 7, the Examiner added the Scheideler reference as disclosing the element of claim 14 (Applicants presume the Examiner intended to refer to the sound sensor of claim 14 rather than the motion sensor as claimed in claim 14). Without addressing this argument on the merits, Applicants rely on the above arguments and assert that the addition of Scheideler to the combination does not provide a teaching or suggestion for the elements of the independent claim.

However, Applicants do note that the sound sensor, as claimed in claim 14 is required to detect the partial movement of the *control element*, Scheideler discloses that the sound sensor 20 detects vibrational motion of a roll of paper and/or at least one nip formed between a roll and an opposing surface (see [0087]). The roll and nip of Scheideler can in no way be construed as the control element of the present invention, nor would the sound sensor of Scheideler be combined in a comprehensive test of the operating safety of a process control device when its detection is based on a component of the process itself.

For these reasons, Applicants assert that the claim language of the independent claims clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the §103(a) rejection from the present application.

CONCLUSION

Inasmuch as each of the objections have been overcome by the amendments, and all of the Examiner's suggestions and requirements have been satisfied, it is respectfully requested that the present application be reconsidered,

the rejections be withdrawn and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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